



OCT 11 2000

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) requests for regrading question 26 of the morning section and questions 27, 48, and 49 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 69. On July 25, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 26 and afternoon questions 27, 48 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 26 reads as follows:

26. Which of the following statements is most correct?

- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the "how to use" and "how to make" requirements of 35 U.S.C. §112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 U.S.C. § 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 U.S.C. § 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner's acts do not inure to the benefit of the inventor.

The model answer is choice (C).

(C) is the most correct answer as per *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP § 2138.05 (section styled "Requirements To Establish Actual Reduction To Practice"). (A) is incorrect. MPEP § 2138.05, (section styled "Requirements To Establish Actual Reduction To Practice"). The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP § 2138.05 (section styled "Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph"). *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require "an inventor or his attorney to drop all other work and concentrate on the particular invention involved"); MPEP § 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP § 2138.06 (section styled "Diligence Required In Preparing And Filing Patent Application"). *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

Petitioner argues that answer (A) is correct because one can have a winning date of constructive reduction to practice without actual reduction to practice having occurred.

Petitioner contends that answer (C) is incorrect because a method does not have to be successfully performed to have an actual reduction to practice. Petitioner concludes that answer (C) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. The answer (A) specifically states that the same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice. The statement in (A) makes no reference to the equivalence of dates for reduction to practice, but only that the evidence needed for constructive reduction is sufficient to show actual reduction. The evidence is not the same because while actual reduction requires a showing of the invention in a physical or tangible form containing every element, constructive reduction to practice does not require such a showing. Accordingly, the statement in answer (A) is incorrect.

The statement in answer (C) is correct because a method does have to be successfully performed to have an actual reduction to practice, *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928), "A process is reduced to practice when it is successfully performed." Since the statement in answer (C) is correct and the statement in (A) is incorrect, no error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. A patent application is filed with the following original Claim 1:

A steam cooker comprising:

- (i) a steam generating chamber having a steam generator;
- (ii) a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- (iii) a heat exchanger secured within said steam generator, said heat exchanger including at least one heating zone comprised of an inner having raised surface projections thereon, an outer panel having raised surface projections thereon, and

a path between said raised surface projections whereby flue gases may pass for heating the walls of the heat exchanger.

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 4, after "steam" insert, --generator--.
- (B) In Claim 1, line 6, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, line 3, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and--.
- (E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

The model answer is choice (B).

(B) is the most correct answer as per 37 C.F.R. § 1.121; MPEP § 714.22. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made, and is limited to five words or less. (A) is also correct because there is only one occurrence of "steam" in line 4, which serves to specify the exact location where the insertion is to occur. (C) is incorrect because the amendment does not specify the exact point where the insertion of "two" is to occur. (D) is incorrect because the amendment would insert more than five words. (E) is incorrect because it fails to identify the correct point where the deletion and insertion is to be made.

Petitioner argues that answer (C) is equally correct and that because the Office has decided that more than one answer is correct, all answers should be given credit. Petitioner further argues that answer (A) is not correct because the comma in answer (A) is inconsistent with PTO practice and since credit is given to answer (A), all other wrong answers should also receive credit. Petitioner contends that (C) is correct because the standard for amendments should be "sufficient specificity", and that the amendment in (C) has indicated the insertion point for "two" with sufficient specificity. Petitioner concludes that answer (C) should be given credit.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the standard for amendments is sufficient specificity,

37 C.F.R. § 1.121 (a)(2)(i) states "Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and **the precise point where the deletion or insertion is to be made.**" (Emphasis added.) Answer (C) fails to show precisely where "two" is to be inserted and therefore answer (C) is incorrect.

The comma in answer (A) is not prohibited by 37 C.F.R. § 1.121. Also see MPEP § 714.22. Therefore, the comma in answer (A) does not make it incorrect. Furthermore, there is no basis for extending the credit given for 2 correct answers in a question to granting equivalent credit for the incorrect answers. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.
- (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
- (E) Obviousness can be predicated on what is not known at the time an invention is

made, where the inherency of the feature is later established.

The model answer is choice (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification..."); MPEP § 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP § 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is incorrect. MPEP § 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP § 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP § 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry"), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that (B) is correct and (D) is incorrect. Petitioner contends that answer (D) is incorrect because properties inherent in the subject matter may not be considered if they are not disclosed in the specification or known to one of ordinary skill in the art. Petitioner provides an extensive grammatical critique of answer (D) to show that the answer has two independent assertions: (1) consideration is given to the properties of the subject matter which are inherent in the subject matter; and (2) consideration is given to the properties of the subject matter disclosed in the specification. Petitioner contends the first of these two contentions is incorrect. Petitioner contends that answer (B) is correct because it is part of the *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966), factual inquiry.

Petitioner's argument has been fully considered but is not persuasive. Answer (B) states "The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious." As petitioner correctly notes the differences form a part of the factual inquiries that forms the background for determining obviousness, but the differences do not resolve the entire inquiry of obviousness. The claimed invention and the references must be considered as a whole. See MPEP 2141, right column of page 2100-90. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See MPEP 2141.02 and *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Answer (B) is incorrect because it states that the differences **resolve**, i.e. answers the entire inquiry.

As to answer (D), the Court in *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977), specifically stated "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter **which are inherent in the subject matter and are disclosed in the specification...**" (Emphasis added.) This shows the correctness of answer (D) and negates petitioner's arguments both by stating that consideration is given to the invention as a whole, which necessarily incorporates all properties, and by grammatically mirroring answer (D). To the extent answer (D) is subject to multiple interpretations, so is the case that demonstrates the correctness of answer (D). Therefore, answer (D) cannot be negated on grammatical grounds. Further *Antoine* and MPEP § 2141.02 both state that the invention as a whole is considered

which necessarily includes inherent properties. Accordingly, answer (D) is correct and answer (B) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice (E).

The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically not abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 ("If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first."). See MPEP § 710.01(a), fourth paragraph.

Petitioner argues that answer (A) is correct. Petitioner contends that the question did not state that shortened statutory time periods were assigned to applications C and D, in which case, both were copending when application E was filed and application E could properly claim the

benefit of the filing dates of applications C, D and B. Petitioner concludes that the earliest effective filing date of application E is October 21, 1993, thus answer (E) is incorrect.

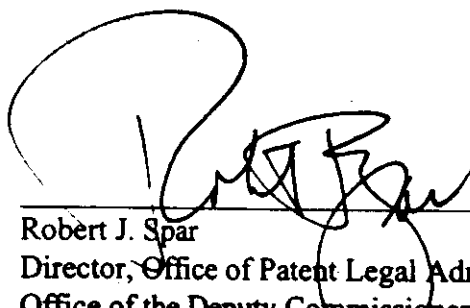
Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the question did not state that shortened statutory periods were assigned to applications C and D, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. As explained in MPEP § 710.02(b), under the authority given him by 35 USC § 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. That same MPEP section also states that such shortened period is 3 months to reply to any Office action on the merits. Accordingly, applications C and D are assigned shortened statutory periods according to the PTO rules of practice and procedure, rendering C and D abandoned at the time of application E's filing. Therefore, choice (E) is the correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy